

PATENT

Application No.: 09/609,253
Attorney Docket No.: 00-007**REMARKS**

- Claims 2-47, 50, 59 and 116-125 were pending in the present application
- Claims 2-47, 50, 59 and 116-125 stand rejected

Upon entry of this Amendment:

- Claims 2, 3, 5-47, 50, 59 and 116-125 will be pending in the present application
- Claim 4 will be cancelled
- Claims 2, 49, and 116 will be independent

A. Claim Amendment

Claim 4 has been cancelled without prejudice by this Amendment. We do not agree with the Examiner's rejection of Claim 4, as discussed further herein, and the cancellation is solely in order to expedite allowance of the present application. We intend to pursue the subject matter of Claim 4 in a continuing application.

Claim 2 has been amended. No new matter has been added. We believe that Claim 2 contains allowable subject matter, as discussed further below.

B. Section 103(a) Rejection

Claims 2-5, 18-31, 37-39, 43-47, 49-50, 116-118, and 125 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,950,632 issued to Reber et al. ("Reber"), U.S. Patent No. 5,852,590 issued to de la Huerga, et al. ("De la Huerga"), and U.S. Patent No. 4,768,177 issued to Kehr, et al. ("Kehr").

Claims 6-8, 41-42, and 119-121 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reber, Kehr, de la Huerga and further in view of U.S. Patent No. 6,484,027 issued to Mauney, et al. ("Mauney").

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Reber, Kehr, de la Huerga, Mauney and further in view of U.S. Patent No. 5,589,389 issued to McEwan, et al. ("McEwan").

Claims 10-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reber, Kehr, de la Huerga and McEwan.

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Claim 40 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Reber, Kehr, de la Huerga and further in view of Official Notice (presumably supported by Palasis (U.S. Patent No. 6,689,103)).

Claims 122-124 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reber, Kehr, Mauney and de la Huerga and further in view of Official Notice (presumably supported by Sloane (U.S. Patent No. 5,911,132)).

Claims 32-36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reber, Kehr, and de la Huerga and further in view of U.S. Patent No. 4,682,299 issued to McIntosh, et al. ("McIntosh").

We respectfully traverse all of the Examiner's Section 103(a) rejections.

1. Claims 2, 49 and 116

We respectfully dispute the Examiner basis for rejection of Claims 2, 49 and 116. [We note that the Examiner rejected Claims 49 and 116 on the same grounds as "claim 1" (see page 12), which has been canceled previously. We assume the Examiner meant Claim 2.]

The Examiner relies on a combination of Reber, Kehr and de la Heurga. We dispute the Examiner's asserted motivation to combine the cited references.

Contrary to the Examiner's assertion, there is no suggestion in de la Heurga or Reber of a need for communication between medicine containers, much less wireless communication. Further, the Kehr system is described as involving a set of interconnecting modules. Thus, although Kehr describes communication between modules, because they are interconnecting Kehr does not suggest a need for wireless communication between medicine containers. Thus, there is no motivation suggested in the cited references to provide for wireless communication between two containers for storing medicine.

Also, we note that the combination proposed by the Examiner relies on the Kehr system but would require separating the described interconnecting modules of Kehr, without any motivation for doing so supported by the record. As described in Kehr, it is the interconnecting system, relying on one (presumably more expensive) base module, that provides for some of the cost-effectiveness of the Kehr system and relied upon the Examiner as a motivation (see page 3). The purported motivation, therefore, would not seem to suggest the modification of Kehr proposed by the Examiner (to allow for wireless communication).

In addition, independent Claim 2 now recites features generally directed to wirelessly communicating *a signal including an indication of a number of times*

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that the second container is beyond a range in which the first container is able to communicate with the second container and generating at least one code based at least in part on the signal, the at least one code indicating whether at least one party has complied with a schedule for taking the first medicine and the second medicine. Some embodiments of the present invention provide for proximity information to include the number of times each medicine container has been moved beyond a range wherein the medicine container may communicate with the other medicine containers. A level of compliance to a medicine schedule may be based at least in part on such proximity information [See, e.g., Specification, page 37, lines 1-7]. The cited references do not teach or suggest any such features or the desirability of compliance with a schedule for taking medicines that is based on an indication of a number of times one container is beyond a range in which another is able to communicate with it.

The Examiner has thus failed to establish a *prima facie* case of obviousness of Claims 2, 49 and 116 (or any claim dependent therefrom).

2. Claim 3

We respectfully dispute the Examiner's basis for the rejection of Claim 3.

The Examiner asserts that de la Heurga teaches transmitting information regarding a first medicine from a first container to a second container and receiving information regarding the second medicine from the second container. De la Huerga (including the cited portions) does not appear to teach any such features.

The Examiner has thus failed to establish a *prima facie* case of obviousness of Claim 3.

3. Claims 4 and 36

We respectfully dispute the Examiner's basis for the rejection of Claims 4 (now cancelled) and 36.

The Examiner asserts that de la Heurga teaches generating at least one code indicating whether at least one party has complied with a schedule for taking a first medicine and a second medicine. De la Huerga (including the cited portions) does not appear to teach any such features. There is no hint of a code that indicates compliance, much less compliance with a schedule for taking more than one medicine.

The Examiner has thus failed to establish a *prima facie* case of obviousness of Claim 4 (now cancelled). The Examiner rejects Claim 36 on the same basis (see

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page 22), and has thus failed to establish a *prima facie* case of obviousness of Claim 36.

4. Claim 5

We respectfully dispute the Examiner's basis for the rejection of Claim 5.

The Examiner asserts that de la Heurga teaches outputting at least one code to at least one of a representative of an insurance company, a representative of a pharmacy and a representative of a medical facility. De la Huerga (including the cited portions) does not appear to teach any such features.

The Examiner has thus failed to establish a *prima facie* case of obviousness of Claim 5.

5. Claim 24

We respectfully dispute the Examiner's basis for the rejection of Claim 24.

The Examiner concedes that none of the cited references teaches or suggests detecting a weight of a first container, much less detecting if a portion of the first medicine has been removed from the first container by detecting the weight of the first container. There is no evidence (much less substantial evidence) of such features in the record.

Thus, the Examiner has thus failed to establish a *prima facie* case of obviousness of Claim 24.

6. Claims 33-36

We respectfully dispute the Examiner's basis for the rejection of Claim 33.

The Examiner relies on McIntosh as teaching the detecting if a party attempts to take a first medicine within a predetermined time period. We do not agree with this reading of McIntosh. The cited portion of McIntosh appears to be directed simply to detecting incompatibilities in the programming of a "medication clock." There is nothing in McIntosh that suggests detecting if a party actually attempts to take a first medicine within a predetermined time period of taking a second medicine.

Thus, the Examiner has thus failed to establish a *prima facie* case of obviousness of Claim 33 (and Claims 34-36 dependent therefrom).

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We respectfully dispute the Examiner's basis for the rejection of Claim 41.

The Examiner concedes that none of the cited references teaches or suggests preventing a party from accessing at least one of the first and second medicines if the first and second containers cannot communicate. There is no evidence (much less substantial evidence) of such features in the record. Also, there is no evidence offered in support of the purported motivation (i.e., desirable to prevent taking a medication "where they would not be able to take all medications that may be required").

Thus, the Examiner has thus failed to establish a *prima facie* case of obviousness of Claim 41.

For at least the reasons stated herein, we respectfully request allowance of the pending Claims 2, 3, 5-47, 49, 50 and 116-125.

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It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mtdowns@walkerdigital.com.


D. Petition for Extension of Time to Respond

We hereby petition for a TWO-month extension of time with which to respond to the Office Action. Please charge \$210.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

September 7, 2004
Date

Respectfully submitted,



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